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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,846	11/24/2003	Susan A. Cook		2926

7590 11/19/2007
John J. Welch, Jr., Esq.
8 E. Center Street
Rutland, VT 05701

EXAMINER

REDDING, DAVID A

ART UNIT	PAPER NUMBER
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3723

MAIL DATE	DELIVERY MODE
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11/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,846

Applicant(s)

COOK, SUSAN A.

Examiner

David A. Redding

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/5/07; 4/6/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the amendment to claim 2, filed 3/5/07, and to the amendments to claims 3-6, filed 4/6/07.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article authored by Paula Gardiner in view of USP 5,607,754 (Giles et al.).

Page 2 of the Gardiner article discloses that Peppermint oil can be applied externally as an analgesic, anesthetic, antipruritic or counter-irritant (page 16). The composition of the peppermint oil is 10% oil with remaining ethanol (page 11). Applied externally, liquid (aqueous based) compositions range from 0.1% to 16% m/m (page 16), which is considered to read on the dilution defined in claim 4. The Gardiner

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reference is silent as to the dilute liquid composition impregnated within a piece of paper.

USP 6,475,976 to Mahieu et al. disclose a piece of paper impregnated with an aqueous solution containing peppermint and ethanol. The piece of paper is disclosed as being from 10% - 90% weight wood pulp fiber (col.8, lines 35-40). It would have been obvious to one skilled in the art to use the paper product in Mahieu et al. as a means to apply the aqueous peppermint oil solution externally as a rub or liniment in view of the paper products known use of applying an aqueous solution of peppermint/ethanol to a surface.

The wood pulp percentage specified in claims 2 and 3, the weight density specified in claims 2 and 5, are considered to be obvious result-effective variables of the paper product disclosed in Mahieu et al. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

In the absence of unexpected results the dimensions specified in claim 5 are obvious. In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,403,587 (McCue et al) in view of USP 6,475,976 to Mahieu et al.

McCue et al. disclose an aqueous composition comprising about 0.02 to about 5 weight % of an essential oil (peppermint), about 0.10 to about 95 weight % of a solubilizing agent (ethanol), and the remainder being made up of water (col. 3, lines 10-17; col. 3, line 61; col. 4, lines 12-18). This composition is considered to read on the dilution ratios claimed. The reference further discloses that the aqueous composition can be applied to a surface by impregnating a towelette (col. 5, lines 50-54). The reference is silent as to the wood pulp percent.

USP 6,475,976 to Mahieu et al. disclose a piece of paper impregnated with an aqueous solution containing peppermint and ethanol. The piece of paper is disclosed as being from 10% - 90% weight wood pulp fiber (col.8, lines 35-40). It would have been obvious to one skilled in the art to use the paper product in Mahieu et al. as a means to apply the aqueous peppermint oil solution externally as a rub or liniment in view of the paper products known use of applying an aqueous solution of peppermint/ethanol to a surface.

The wood pulp percentage specified in claims 2 and 3, the weight density specified in claims 2 and 5, are considered to be obvious result-effective variables of the paper product disclosed in Mahieu et al. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

In the absence of unexpected results the dimensions specified in claim 5 are obvious. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Response to Arguments

Applicant's arguments filed 3/5/07 have been fully considered but they are not persuasive.

In response to applicant's argument that the Gardner article does not disclose a composition for cleaning a horse bit, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Redding whose telephone number is 571-272-1276. The examiner can normally be reached on Mon.-Fri. 6:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ David Redding /
Primary Examiner
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DAR